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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANT(S) : Chu, et al.
SERIAL NO. : 09/849,870
FILED : May 4, 2001
FOR : THERAPEUTIC AZIDE COMPOUNDS

GROUP ART UNIT : 1623
Examiner : Patrick T. Lewis

Commissioner for Patents
Washington, D.C. 20231

Election of Invention in Response to Restriction Requirement

In response to the Examiner's correspondence dated October 3, 2002, pursuant to the Examiner's restriction requirement in the above-referenced patent application, Applicants provisionally elect with traverse to prosecute the invention of group I, namely claims 1 and 7-13, which are drawn to a pharmaceutical composition comprising an azide derivative of a drug and a suitable pharmaceutical carrier, classified in class 514, subclass 42.

Applicant respectfully traverses the Examiner's requirement for restriction. Applicant respectfully requests the Examiner reconsider his restriction requirement. Applicant respectfully submits that prosecution of all of the originally filed claims should not be restricted to the elected invention, for the reasons which are set forth hereinbelow.

According to M.P.E.P. §803, restriction by the Examiner of patentably distinct inventions is proper if the claimed inventions are independent and a ***serious burden*** would be placed on the Examiner if restriction was not required. Applicant respectfully submits that the presentation of the originally filed claims would not place such a serious burden on the Examiner as to require restriction. All of the originally filed claims are related, though patentably distinct chemical compositions, methods of increasing the half-life of a drug and methods for ameliorating a pathological condition.

Although the claimed invention groups are generally patentably distinct from each other, Applicant respectfully submits that any search the Examiner would need to conduct in examining the instant application would not be unduly burdensome. This is clearly evidenced by the Examiner indicating that the searches for the examination of all the claims of the instant application ***fall within the identical class (514) and subclass (42).*** Moreover, the examination of all of the originally filed claims in the instant application would not place such a serious burden on the Examiner as to require restriction. This is particularly true given the fact that the present application is a divisional application, the Patent Office has already had the opportunity of examining the claims in the parent application and all of the claims are directed to inventions which are classified in the identical class and subclass.

Applicants understands the general policy considerations for the Patent Office's requirement for restriction in certain instances. In this instance, however, those considerations do not weigh in favor of restricting the inventions here. In determining the appropriateness of restriction, one must also consider the countervailing consideration that, in each instance, Applicant wishes the Patent Office to examine his or her application with a certain degree of "administrativel efficiency" and wishes to have patent claims issue which reflect the breadth of his or her invention.

Applicants respectfully submit that the originally filed claims are sufficiently narrow to allow the Examiner to determine patentability without being subjected to the serious burden referred to in M.P.E.P. §803. Consequently, Applicant respectfully requests that the Examiner withdraw the restriction requirment. Alternatively, Applicants respectfully request that the Examiner extend consideration to examining all of the claims of groups I and II inasmuch as the compositions and methods are found in the identical class and related subclass and are conceptually related inasmuch as the pharmaceutical compositions of invention group I are prodrug forms of an active drug and the invention of invention group II are directed to a method for increasing the half-life of a drug, inventions which are conceptually quite related.

The Examiner is cordially requested to call the undersigned attorney if the Examiner believes that a telephonic discussion may materially advance the prosecution of the instant application in any way.

Respectfully submitted,

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By: _____

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Dated: November 4, 2002

Certificate of Mailing

I hereby certify that this correspondence is being deposited with the U.S. Postal Service as first class mail in an envelope addressed to: Commissioner of Patents, Washington, D.C., 20231, on November 4, 2002.

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